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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,078	01/28/2002	Thomas J. Perkowski	100-058USANA0	7339

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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

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06/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/059,078	Applicant(s) PERKOWSKI, THOMAS J.	
	Examiner Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/4/05, 9/6/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 48 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 47. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

Claim 47 is objected to because of the following informalities:

- Claim 47, "product" should be replaced by --service--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 17-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 17-48 – most if not all these apparatus/system claims include limitations that appear to be method steps which confuse the scope of these apparatus claims. Applicant should present code, programming, or items configured with the ability to accomplish a function rather than claiming performance of the function. It is unclear what apparatus structure if any applicant is requiring by this language. For example:
 - Claim 17 includes language that services are registered and that the kiosk is launched.
 - Claim 18 includes language that the spot is displayed and links are displayed.
 - Claim 25 includes language that a document is served.
 - Claim 26 includes language that a server serves links.
 - Claim 27 includes language that a tag is executed, a request is carried out.
 - Applicant should review all claims 17-48 for compliance in this regard.

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- Claim 33 is confusing in scope because the limitations appear to be already present in base claim 17.
- Claims 35, 37, there is no antecedent basis for said third Internet-based subsystem.
- Claim 37, there is no antecedent basis for said promotional display mode.
- Claim 39 is confusing in scope because the limitations appear to be already present in base claim 24.
- Claim 40, it is unclear how an HTML document can be an image. Contain an image, yes – be an image, no.
- Claim 44, it is unclear how the type of person listed can further define the structure/capabilities of the apparatus.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 17-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern (US6591247) in view of Durst, Jr. et al (US6542933).**

7. Regarding claims 17-30, 33-48, Stern teaches systems and methods for providing networked, in-store kiosks that can be used to deliver product information and advertisements. It would have been obvious to one of ordinary skill at the time of the

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invention to have provided such a system for services as well as products in order to educate consumers about offered services too. A centralized server (NMC/NOC 12/20) receives various types of content (ads, information, audio, video, etc) and makes the content available to various stores [fig 1]. Each store has plural kiosk sites 30 including an LCD panel/video screen, keyboard and light pen. The kiosks and servers are connected by way of IP protocol and/or the Internet [4:46-68]. A consumer can scan the UPC barcode (Universal product number UPN) of a product at the kiosk and receive advertising and other information about the product [6:46-50, 7:14-17, 27-32, 48-50] which provides a positive brand experience. It would have been obvious to one of ordinary skill at the time of the invention to have requested information about a service using any identifier such as a USN, SM or SD which uniquely identifies the service in question. Stern teaches that the central database provides a UPC-indexed (i.e. relational) database (RDBMS server) of products that stores the relationship (via the tblUPCmaster table) between the UPC codes and the associated content (ads, information, audio, etc) associated with that product [8:10-25]. Stern teaches that functionality is provided to input ads/information into the system [6:1-34] which is taken to represent programming of the various information modes. Stern teaches that a management user interface is provided for viewing and creating the tables in the database which determine the content, content delivery mechanisms and links for the kiosks. It is unclear whether management workers must interface the system locally or remotely. However, Stern teaches a distributed system of complex subsystems which communicate over various networks including the Internet and it would have been obvious to one of ordinary skill at the time of the invention to have provided the

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management user interface as a web-enabled interface (remote GUI) in order for any remotely located manager to access and program the system. The display of ads and information to the requesting user about the requested item is taken to provide a virtual kiosk that displays advertisements and information which are taken to promote the item. Any web page displaying any content about the requested item is taken to be a "virtual kiosk." The server links the user to the URL of the associated information [3:15-30, 66-67]. Although any advertisement content delivered through an advertising mode is taken to promote the item advertised, therefore providing a promotion and promotion mode, Durst, Jr. et al teaches product descriptions as well as product promotions [col 23 lines 7-29]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a mode for displaying product promotions as well Stern's displaying advertising mode and product information mode in order to provide more brand awareness and encourage the consumer to purchase a particular brand. The display of the links of Stern is taken to provide a subsystem which provides for a URL link display mode. Stern does not appear to provide the dynamic web application (UPC-specific information) as one with the use of embedded "tags" in the HTML web pages. Durst, Jr. et al however does teach that a web-based product information system can be provided by use of a Java servlet located at the server [col 6 lines 47-49]. It is taken to be inherent that provision of a JAVA servlet is accompanied by the necessary <tags> embedded in the web documents that are to provide the server functionality when the user desires to interact with the server to obtain the requested information. It would have been obvious to one of ordinary skill at the time of the invention to have provided access to the interactive server processes of Stern using embedded tags that point to

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the proper JAVA servlet in a manner as taught by Durst, Jr. et al. The ads, promos and CSI product information provided by the combination are taken to originate from a server(s) which stores and serves such information. Stern teaches that the site having the kiosk can also include e-commerce access [5:52]. The system of Stern is taken to provide management with a means (subsystem) for creating the necessary links/indexes/keys of UPN/TM/PD (or USN/SM/SD in the obvious case for services) to the associated content in the databases. It would have been obvious to one of ordinary skill at the time of the invention to have labeled the provided links with such items in order to describe the link to the user for clarity. Further, Stern teaches providing ads, audio, video and information about the item. Durst, Jr. et al teaches providing product and other types of information about products. It would have been obvious to one of ordinary skill at the time of the invention to have returned a list of URL links to the user when the product/service requested is associated with plural content files (ads, promotions, information, warranty, etc), so that the user may choose which content to review.


Regarding claims 31, 32, Stern teaches user input in order to navigate through a web interface, but does not teach a touch screen. Official Notice is taken that using touch screens in a kiosk are well known. It would have been obvious to one of ordinary skill at the time of the invention to have provided a touch screen with the virtual kiosk terminals of Stern for ease of navigation. Further, kiosks are well known to include a screen mounted on a shelf off the floor so that the display is at a comfortable height for the kiosk users. It would have been obvious to one of ordinary skill at the time of the invention to have done so with the terminals of Stern.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc